

## REMARKS

1           The Examiner objected to the drawings under 37 C.F.R. 1.84(p)(5) for failing to  
include reference sign 26'. The applicant respectfully submits corrected Figure 5  
herewith, which contains the previously omitted reference sign. Accordingly, the  
drawings are believed to be in an allowable condition.

5           The Examiner rejected claims 1 and 4 under 35 U.S.C. § 102(b) as being  
anticipated by Kater (5,046,509). However, Kater does not teach or otherwise disclose  
a gasket that is slidably coupled with a tube. Nowhere within the reference does Kater  
disclose the sleeve 112 as being slidably coupled to the outer surface of the tube 100.  
10          Rather, the Kater specification, at column 3, lines 20-22, states that the "cylindrical seal  
108 includes a central aperture 110 within which the mounting end 104 of the needle  
100 is fixedly attached." Accordingly, claim 1 is believed to be allowable, since a claim  
is anticipated only if each and every element as set forth in the claim is found, either  
15          expressly or inherently described, in a single prior art reference. Verdegaal, Bros. v.  
Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

          Claim 4 depends from claim 1 and is believed to be allowable for at least the  
reasons set forth hereinabove with respect to claim 1. Claim 4 has been amended to  
specifically state that the distal end portion of the tube is angularly disposed with  
20          respect to the remainder of the tube. The distal end portion of the needle disclosed in  
Kater is cut on a bias to provide a sharp point. It is not angularly disposed with respect  
to the remainder of the tube. Accordingly, claim 4 is believed to be allowable.

1 The Examiner rejected claim 8 under 35 U.S.C. § 102(b) as being anticipated by  
Kramer et al. (4,969,870). The applicant respectfully disagrees with the rejection.  
However, claim 8 has been amended to more accurately state the limitation with the  
claim. Claim 8 now states that the "distal end portion of said sleeve having a sealing  
5 surface that can be selectively positioned against the bone, around an opening to said  
bone cavity, to seal said bone cavity while said suction mechanism provides negative  
pressure to said bone cavity." This language is not "intended use language" but rather  
language that serves as a limitation on the nature and composition of the distal end  
portion of the sleeve. Not all objects are physically capable of performing the recited  
10 function. The applicant's specification and figures disclose such a structure, as claimed.  
The Kramer reference teaches a base 19 having a "generally flat lower surface 21  
adapted for placement against the patient's skin 23" (col. 4, lines 2-3) and "suitable  
surface texture (not shown) or other irregularity in the handle's outer surface will  
15 facilitate such grasping." (Col. 5, lines 30-32). The reference further states that its  
purpose is to: 1) provide lateral support and alignment . . . and stabilize the apparatus  
on the patient's skin; 2) serve as a support for the spring 39; and 3) provide a grip  
surface for the operator. (Col. 5, lines 21-29). Nothing in the specification or figures  
20 suggest that the base 19 is capable of sealing engagement around an opening formed  
in a bone. The examiner is respectfully requested to reconsider the aforementioned  
rejection and allow claim 8.

25 The Examiner has rejected claims 2 and 5 under 35 U.S.C. § 103(a) as being  
unpatentable over the Kater reference in view of Lee et al. (5,693,030). The Examiner

1 states that Kater fails to teach openings in the distal end of the tube or the use of an  
obturator but that the Lee reference teaches such structures. Claims 2 and 5 each  
depend from claim 1 and are believed to be allowable for at least the reasons set forth  
hereinabove with respect to claim 1.

5 In determining the difference between the prior art and the claims, the questions  
under 35 U.S.C. § 103 is not whether the differences themselves would have been  
obvious, but whether the claimed invention as a whole would have been obvious.  
Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A  
prior art reference and the claimed invention must be considered in their entireties.  
10 Distilling an invention down to the "gist" or "thrust" of an invention disregards the  
requirement of analyzing the subject matter "as a whole." W. L. Gore & Associates,  
Inc. v. Garlock, Inc., 721 F.2d 1540 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469  
U.S. 851 (1984).

15 The mere fact that the references can be modified does not render the resulting  
modified structure obvious unless the prior art also suggests the desirability of the  
combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "A  
statement that modifications of the prior art to meet the claimed invention would have  
been 'well within the ordinary skill in the art at the time the claimed invention was made  
20 because the references relied upon teach that all aspects of the claimed invention were  
individually known in the art' is not sufficient to establish a *prima facie* case of  
obviousness without some objective reason to combine the teachings of the  
references." Ex parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

1 Along with the openings in the distal end portion and the use of the obturator,  
Kater does not teach a device that reads upon the limitations of the subject claims (as  
described hereinabove). Lee et al. teach a simple catheter for use in sampling large,  
open body cavities. A person of skill in the art who was looking to provide an improved  
5 device for creating negative pressure within a bone, to draw adhesive material inward  
from outside the bone, would not, on any objective, basis look to the teachings of the  
Lee et al. reference. Just because a structural detail is simple and known for other  
purposes, does not render it "obvious". In In re Kotzab, 217 F.3d 1365, 55 USPQ2d  
1313 (Fed. Cir. 2000), the Federal Circuit Court of Appeals decided that the control of  
10 multiple valves by a single sensor rather than by multiple sensors was a technologically  
simple concept. However, the Federal Circuit held that there was no finding as to the  
specific understanding or principle within the knowledge of the skilled artisan that would  
have provided the motivation to use a single sensor as the system to control more than  
15 one valve.

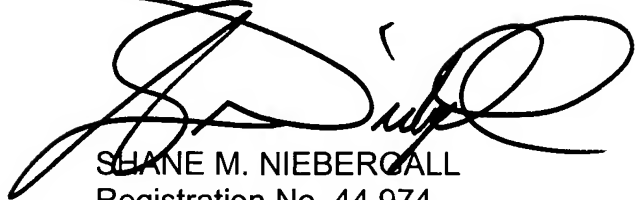
Obviousness can only be established by combining or modifying the teachings of  
the prior art to produce a claimed invention where there is some teaching, suggestion,  
or motivation to do so, found either explicitly or implicitly in the references themselves or  
in the knowledge generally available to one of ordinary skill in the art. No teaching  
20 motivation or suggestion can be found within the cited prior art that teaches or suggests  
the combination suggested. Accordingly, the claims are believed to be patentably  
distinct from the prior art and the Examiner is respectfully requested to reconsider  
claims 2 and 5 and allow the same.

1 The Examiner has rejected claim 3 under 35 U.S.C. § 103(a) as being  
unpatentable over Kater in view of Dubinsky (WO 99/52441). Specifically, the Examiner  
states that Kater fails to teach a tube having an arcuate portion, as shown in Dubinsky.  
Claim 3 depends from claim 1 and is believed to be allowable for at least the reasons  
set forth hereinabove with respect to claim 1. Kater fails to teach a structural device as  
5 described by the examiner with respect to the slidability of the tube with respect to the  
sealing gasket. Moreover, as discussed previously with regard to claims 2 and 5, the  
combination of claimed elements is believed to be patentable. Simple, combinable  
elements from the prior art do not necessarily render the claimed limitations obvious.  
10 Here, there is no teaching or suggestion that would render the claimed invention  
"obvious". Accordingly, the Examiner is respectfully requested to reconsider the  
aforementioned rejection and to allow claim 3.

15 In light of the above amendments and remarks, applicant asserts that the claims  
are in condition for allowance. Applicant respectfully requests reconsideration and  
allowance of the same.

20 No fees or extensions of time are believed to be due in connection with this  
amendment; however, please consider this a request for any extension inadvertently  
omitted, and charge any additional fees to Deposit Account No. 502093.

Respectfully submitted,

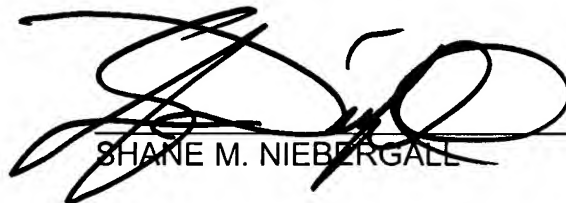


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**CERTIFICATE OF MAILING**

I hereby certify that the original of this AMENDMENT for R. MICHAEL GROSS,  
Serial No. 10/046,592, was mailed by first class mail, postage prepaid, to Mail Stop  
Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on  
this 5th day of January, 2005.

  
SHANE M. NIEBERGALL